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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 6385.00001	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number  09/878,860	Filed  June 9, 2001	
	First Named Inventor  George M. Mockry		
	Art Unit  3711	Examiner  M. Chambers	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div><div>I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number 29,864 <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</div><div> Signature Joseph M. Skerpon Typed or printed name 202-824-3000 Telephone number September 8, 2005 Date</div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p> <div><input checked="" type="checkbox"/> *Total of 1 forms are submitted.</div>			

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application Of:	)	Confirmation No. 8653
	)	
George Michael MOCKRY et al.	)	Group Art Unit: 3711
	)	
	)	Examiner: M. Chambers
Serial No.: 09/878,860	)	
	)	Customer No. 22907
	)	
Filed: June 9, 2001	)	Attorney Docket No.: 006385.00001

For: **METHOD OF RECORDING AND PLAYING BASEBALL GAME SHOWING EACH BATTER'S LAST PITCH**

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**I. SUMMARY OF CLAIMED SUBJECT MATTER**

The invention encompasses a method for re-broadcasting or re-marketing a pre-recorded baseball game. In particular, the invention relates to methods for presenting a baseball game in a condensed fashion for viewing (and re-viewing) and for generating additional revenue. There are four independent claims under consideration, claims 23, 24, 35 and 38. One of the key features of each of these independent claims is the concept that the re-broadcasted game consists essentially of three aspects of the original game action (i) the final pitch thrown to every batter and any game action resulting from the final pitch, (ii) successful attempts of runners on base to advance to another base not associated with the game action resulting from the final pitch and (iii) unsuccessful attempts of the runners on base to advance to another base resulting in an out not associated with the game action resulting from the final pitch.

Each of the independent claims has its own set of operative steps. Claim 23 requires that (1) pre-recorded video of the entire game be edited to consist essentially of the game action noted above, (2) subscribers for viewing the edited video be obtained and (3) that the edited video be broadcasted to the subscribers. In claim 24, the step of recording the original game action is positively required. Claims 35 and 38 are focused more directly on business methods which parallel claims 23 and 24 respectively, but require that the edited video be broadcasted to subscribers in exchange for monetary consideration.

## **II. GROUNDS OF REJECTION TO BE REVIEWED**

Whether claims 23-40 are obvious (35 U.S.C. 103(a)) based on SeasonTicket in view of Rangan.

Whether claims 23-40 are obvious (35 U.S.C. 103(a)) based on Historicfilms in view of Rangan.

## **III. ARGUMENT**

### **THE COMBINATION OF EITHER SEASONTICKET OR HISTORIC FILMS WITH RANGAN ET AL, U.S. 6,493,872 DOES NOT PRESENT A PRIMA FACIE CASE OF OBVIOUSNESS**

The basic thrust of the Examiner's rejection is that the invention is simply a way of editing video, that the duration and subject matter is merely a matter of a design choice, that there are no unexpected results in that recording and that the content of an edited video contains no patentable novelty.

We submit that the comments made in the Final Office Action in support of the rejection, evidence a complete lack of an understanding of the claimed invention. The claimed invention, as defined by each of the independent claims, is a method. That method may require as one of its steps the preparation of an edited recording, but the actual subject matter of the edited recording itself is not claimed. Thus, the assertion in the Final Office Action that "the content of an edited video contains no patentable novelty" is irrelevant and inappropriate. Applicants do not understand the purpose for that comment in the Final Office Action. The claims do not embrace an edited video.

The Final Office Action also contends, in referring to the primary cited reference, that "SeasonTicket discloses recording personalized sport video highlight shows (page2 2<sup>nd</sup> paragraph).<sup>1</sup> The duration and subject matter recorded is a matter of design choice to the viewer."

We submit that the Examiner has read more into this service than actually was involved. Applicants submit that the "viewer" did not have any input into the original selection of the game action highlights themselves (as it appears the Final Office Action assumes). Rather, we submit that the service embraced by the cited reference merely required that a subscriber first define an

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<sup>1</sup> The citation to HistoricFilms is even less relevant (and will not be addressed separately), as it is simply a video clip containing a collection of baseball (and related) highlights through the early part of the 20<sup>th</sup> Century. No part of the clip could even be considered any one of (1) A method of replaying or rebroadcasting a baseball game (claim 23); (2) A method of providing a subscription for viewing a recorded baseball game (claim 24); (3) A method of obtaining revenue by replaying or rebroadcasting a condensed baseball game (claim 35), or (4) A method of obtaining revenue from editing a recorded baseball game (claim 38). There is not even a suggestion, let alone a disclosure, of editing the game action of a baseball game in the manner required by the claims.

area of interest (it may be a single sport, it may be a set of teams from a single town, or it may be several teams of different sports and different towns). With that defined that area of interest, SEASONTICKET then sends only those highlights (of the full set of highlights that it has access to), that fall within the defined area of interest for that subscriber. For example, a subscriber who expresses an interest only in the Boston Red Sox's (baseball) and the Oakland Raiders (football) would only be sent the highlights, of all the highlights otherwise available through SEASONTICKET, for only those two teams. Highlights of other teams and other sports that might otherwise be available for viewing through SEASONTICKET would not be sent to that particular subscriber. Nothing is said in the SEASONTICKET document about the method for obtaining the specific game action comprising the highlights.

Such a service and the method of its implementation neither discloses, nor suggests the method defined by the pending claims.

The assertion in the Final Office Action that "the specification provides no unexpected results in recording the action plays of the game" constitutes an impermissible attempt to shift the burden of demonstrating patentability to Applicants. It is the burden of the Patent and Trademark Office (PTO) to present a *prima facie* case of obviousness of the invention defined by applicants' claims, it is not applicants' burden to show the "criticality" or "unexpected results" of the invention, unless and until the PTO *prima facie* shows that the invention (method) would have been obvious to a person of ordinary skill in the art. As demonstrated below, the rejection does NOT present a *prima facie* case of obviousness.

The Final Office Action argues that deciding what portion of a pre-recorded video to select (or edit) is simply a design choice ("editing decision"). But, the exercise of a design choice is at the heart of any invention that involves a new way of using established technology. Such an approach to assessing patentability ignores the proper method for determining the issue of non-obviousness established by the U.S. Supreme Court in *Graham v. Deere*. In the present case, the claimed method involves a pre-selection of the game action to be included in the edited recording that breathes patentability into the invention – the attempt in the Office Action to denigrate that non-obvious selection of the game action to include, as simply being a matter of design choice, is based completely on an improper hindsight evaluation of the claimed invention.

The proper question, when addressing the issue of patentability, is whether it would have been obvious to a skilled worker to use the known technology in the manner embraced by the pending method claims. The fact that the invention is one of an infinite numbers of "choices" that confronts a worker of ordinary skill, when using such established technology to edit a video

recording, is of no moment. It is only when illuminated by the improper light of hindsight that the present invention would in any way be considered by a skilled worker.

The invention is NOT directed to simply making a “highlight” tape of a baseball game, as for example one might see on ESPN’s SportCenter. Rather, the invention is directed to a particular pre-selected method of editing a pre-recorded baseball game to show essentially all of, and essentially only all of, the outcome-determinative pitches to each batter (specific game action); while substantially eliminating all non-outcome-determinative action from the edited recording. In this way the edited video shows substantially only the outcome of each at bat in the game, such as the strike-out pitch, the base hit, the home run, the hit batter, the ground out, the fly out, the double play ball, etc. Obviously, such a record is not merely a highlight reel. The concept of making a highlight tape does not suggest making such a pre-selected, edited record of an entire baseball game in the manner defined by the pending claims.

Thus, when one assesses the differences between the cited prior art and the subject matter defined by the pending claims, as required by *Graham v. Deere*, one sees that the game action that one selects resulting in an edited recording is substantially different. A set of highlights, as practiced by the prior art, captures only a few to possibly a dozen events in the course of a game, and generally represents a subjective assessment of those aspects of the game that the editor believes a viewer might find particularly interesting. The present invention, in contrast, establishes an objective, pre-selection of the game action to be included in the edited recording, selecting essentially all of the game action that contributes to the box score of the game. There is nothing in the prior art cited by the Examiner that in any way suggests that one could predicate a new business method, *i.e.*, produce a new product, that would be in demand, *i.e.*, have intrinsic value, independent of common highlight videos by capturing the action of a baseball game in this manner, *i.e.*, by distilling the recording of a baseball game down to essentially only those actions that contribute directly to the outcome of the contest, such as the result that occurs following the last pitch thrown to each batter for each turn at the plate, or the tagging out or safe advancement of a base runner as may occur in a pick-off play or if the runner is caught stealing. Based on applicants’ teachings, anyone with even a rudimentary knowledge of the game of baseball can envision what aspects of the pre-recorded game to exclude and what to retain in the editing process to accomplish the stated result – there is nothing subjective in carrying out the claimed method.

However, before the disclosure of applicants’ teachings, there is not one shred of evidence that those of ordinary skill would have envisioned conducting such a method and

preparing such a product. Of course, one can, within the spirit of this invention, include a minor amount of extraneous recorded information in the edited version according to the present invention, *e.g.*, a video clip of a young fan watching the game, or a video clip of a coach or manager giving signals or changing the pitcher, so as to accent the summary presentation provided by this invention. Also, an accompanying audio track can be used to augment the presentation. Thus, the use of such words as “essentially” and “substantially,” which the Federal Circuit has repeatedly acknowledged are terms implying approximation not exactness, to modify certain aspects of the claimed method, prevents one from slavishly limiting the literal scope of the method to the essential actions. The objective of the invention is to present a complete summary of the action that is recorded in the original game, as reflected in the box score for each participant in the game, so that the action is consolidated into about 10-20 minutes of video and then that product is provided to subscribers.

Indeed, if the claimed method was simply an obvious design choice, why then did Major League Baseball call it “revolutionary” when it first introduced its offering of “Condensed Games.” “Major League Baseball (MLB) today announced the debut of a revolutionary new baseball video service.” (Press Release of March 5, 2002). MLB’s own glowing characterization of this method of doing business stands as a powerful testament of the non-obviousness of the claimed method. This objective indicia of the non-obviousness of the method must be considered when evaluating the patentability of the claimed method. The adoption by MLB of this business method, decades after the pre-recording of baseball games and re-broadcasting of highlights was begun and years after the technology of providing such a product/service over the internet was available, stands as an uncontested tribute to the ingenuity and inventiveness of the claimed method. We submit that such third party commentary unequivocally demonstrates the patentability of the subject matter defined by the pending claims.

The Examiner has completely ignored this evidence by flippantly asserting that it is merely “hyperbole” “well known in the advertising art.” Ignoring such evidence is error.

The citation of the secondary reference Rangan, US 6,493,872 is particularly inappropriate and does not address any of the glaring shortcomings of the primary reference. Rangan describes technology for synchronizing audio and video data streams from different points of origin. Nothing regarding a baseball-related product is mentioned.